

REMARKS

By this amendment, claims 1 through 5, 7 through 24, and 26 through 40 are pending. Claims 6 and 25 are canceled without prejudice or disclaimer. Claims 1, 8, 20, 27, and 40 are currently amended. Adequate descriptive support for the present Amendment is apparent throughout the originally-filed disclosure, e.g., paragraph [67]. Applicants submit that the present Amendment does not generate any new matter issue.

The Office Action mailed April 1, 2011 rejected claims 1 through 19 and 40 under 35 U.S.C. §101 as directed to non-statutory subject matter, claims 1, 6 through 11, 14, 15, 19, 20, 25 through 30, 33, 34, and 40 under 35 U.S.C. §102(e) as anticipated by Pirot et al. (“Pirot”) (US 6,856,676), and claims 2 through 5, 12, 13, 16 through 19, 21 through 24, 31, 32, and 35 through 38 as obvious under 35 U.S.C. §103(a) based on Pirot et al. (“Pirot”) (US 6,856,676) in view of Crawford (US 6,014,651).

Telephonic interview of May 11, 2011.

Applicants express appreciation for Examiner Nguyen’s courtesy in granting and conducting a telephonic interview on May 11, 2011. During the interview the claimed invention and outstanding issues were discussed, and arguments in favor of patentability were presented. Applicants’ attorney pointed out features relating to the specific recitation of the application tier configured to perform order management, and online ordering, as well as the features of claim 6 relating to providing to the web server “callback forms, help center information, or requests for inventory.”

The Examiner viewed favorably combining claims 1 and 6 but indicated that a new search might be undertaken. It is with that understanding that the present Amendment is submitted.

The rejection of claims 1 through 19 and 40 under 35 U.S.C. §101 is respectfully traversed.

The Office Action asserted that independent claims 1 and 40 are interpreted as “a system of software, per se, failing to fall within a statutory category of invention” (Office Action-page 2). The Office Action asserted that the terms “web tier”, “application tier”, “database tier”, and “SAT tier” are interpreted as “software applications” (Office Action-page 2). Applicants respectfully disagree.

Whether or not elements recited in a claim may be implemented via software is not dispositive of whether the claimed subject matter is statutory within the meaning of 35 U.S.C. §101. Applicants are aware of no precedent holding that the employment of software will, *per se*, condemn an invention to the non-statutory realm and challenge the Examiner to cite a single authority holding that “software per se” is unpatentable. In discussing the possibility of the unpatentability of computer programs in *Gottschalk v Benson*, 409 U.S. 63 (1972), the Supreme Court indicated, “We do not so hold.” *In re Bilski*, 544 F.3d 943, 88USPQ2d 1385 (Fed. Cir. 2008) mentions software but only in footnote 25, suggesting that a machine-or-transformation test for patentability of a process under 35 U.S.C. §101 likewise applies to software performing that process. In any event, any “software” that may be recited in claims 1 through 19 and 40 is but merely a part of a claimed “system.” Employing software within a system or apparatus is not precluded under 35 U.S.C. § 101. While the Supreme Court affirmed the judgment of the Federal Circuit in concluding that the claimed subject matter therein was non-statutory, *Bilski et*

al. v. Kappos, 561 U.S. ____ (2010), the Court made it clear that the term “process,” within 35 U.S.C. §101, is **not required** to be tied to a machine or to transform an article, i.e., the Federal Circuit’s machine-transformation test may not be the “sole test” for what constitutes a “process” within the meaning of 35 U.S.C. §101.

Thus, the system of claims 1 through 19 and 40 may be considered to be a “process,” in accordance with 35 U.S.C. §101, for providing software integration for on-line procurement of telecommunications offerings. The claimed system may also be considered to be a “machine,” within the meaning of 35 U.S.C. §101, because, to the extent, the claimed elements are directed to software, the software, as would be well understood by those of ordinary skill in the art, must be executed on a computer, i.e., a “machine.”

In any event, in order to advance prosecution and to simplify issues for potential appeal, independent claim 1 has been amended to recite that the database tier comprises a **database**. Similarly, independent claim 40 has been amended to recite “**a database** for communicating with the application tier.” Moreover, both claims 1 and 40 recite a “web server” (“a web tier configured to receive a request or a user action **from a web server**” in claim 1 and “means for receiving a request or a user action **from a web server** in a web tier and receiving web content responsive to the request or user action” in claim 40), which, as persons of ordinary skill would understand, comprises at least one “processor,” i.e., a machine. A database and a web server comprise physical elements, or machines, that fall squarely within the ambit of 35 U.S.C. §101. FIG. 7 and the attendant description thereof at paragraphs [133]-[143], for example, of the disclosure describe hardware examples of database 707, along with a processor 703 and ROM 705 for storing computer program code instructions for running the processor 703.

Further, as persons of ordinary skill in the art would understand, the elements of the claim may be embodied in software and/or hardware. The manner of embodiment of certain claimed elements should not control the statutory nature of the claimed subject matter. Whether embodied as hardware or software, a machine, i.e., a computer, performs the claimed system steps of receiving a request or a user action from a web server, and to access web content, performing order management, online ordering or user management functions, and establishing a customer portal, pre-qualifying a customer for the telecommunication offerings, and supporting procurement of the telecommunications offerings on-line and custom software objects created to support procuring of the telecommunications offerings on-line. Thus, claims 1 through 19 and 40 clearly recite a statutory “process” or “machine” within the meaning of 35 U.S.C. §101.

Accordingly, claims 1 through 19 and 40 are clearly directed to statutory subject matter, within the meaning of 35 U.S.C. §101, and withdrawal of this rejection is respectfully solicited.

The rejection of claims 1, 6 through 11, 14, 15, 19, 20, 25 through 30, 33, 34, and 40 under 35 U.S.C. §102(e) is respectfully traversed.

Independent claim 1 has been amended to include the features of claim 6 regarding “wherein the application tier includes a back office portal and is configured to provide to the web server, callback forms, help center information, or requests for inventory.” Independent claims 20 and 40 have been amended to include similar features. This claim feature finds support, for example, in FIG. 5, application tier 504, back office portal 518; and paragraph [676] of the specification. Pirot fails to disclose these features.

The Office Action relied on col. 13, lines 14-43 of Pirot for a teaching of an application tier including a back office portal and configured to provide to the web server, context-sensitive

contact information, callback forms, help center information, or requests for inventory. It appears that the Office Action has relied on the disclosed host parameters including name, address, etc., at col. 13, line 26, as corresponding to the claimed alternative of providing “context-sensitive contact information.” Applicants do not agree that the name and address information that constitute the host parameters in Pirot correspond to “context-sensitive” contact information. However, in order to advance prosecution and to simplify issues for potential appeal, “context-sensitive contact information” has been deleted as one of the items provided to the web server. Independent claim 1 now recites, “wherein the application tier includes a back office portal and is configured to provide to the web server, **callback forms, help center information, or requests for inventory**” (Emphasis Added). Independent claims 20 and 40 contain similar features. There is no disclosure, or even a suggestion, in Pirot of providing to a web server any one of these three alternative items. In fact, there is no mention at all, in Pirot of any “forms,” much less “callback forms, or of anything related to “inventory” or help center information.

Accordingly, the rejection of claims 1, 6 through 11, 14, 15, 19, 20, 25 through 30, 33, 34, and 40 under 35 U.S.C. §102(e) is not factually viable. Therefore, withdrawal of his rejection is respectfully solicited.

The rejection of claims 2 through 5, 12, 13, 16 through 19, 21 through 24, 31, 32, and 35 through 38 under 35 U.S.C. §103(a) is respectfully traversed.

Crawford, applied for an asserted teaching of a web tier including reconfigured software objects that include reconfigured JavaServer Pages (JSPs), reconfigured transition policies, or reconfigured display objects, fails to cure the previously argued deficiencies of Pirot.

Accordingly, the rejection of claims 2 through 5, 12, 13, 16 through 19, 21 through 24, 31, 32, and 35 through 38 under 35 U.S.C. §103(a) is neither factually nor legally viable. Therefore, withdrawal of this rejection is respectfully solicited.

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, ability to combine references, assertions as to patentability of dependent claims) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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